

## **REMARKS**

By this Amendment, Applicants amend claims 15 and 28 to more appropriately define the present invention. Claims 5, 6, and 15-28 are currently pending.

In the Office Action, the Examiner rejected claims 5 and 6 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,240,241 to Yuen ("Yuen"); rejected claim 25 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,813,434 to Noguchi et al. ("Noguchi"); rejected claim 24 under 35 U.S.C. § 103(a) as unpatentable over Noguchi; rejected claims 26 and 27 under 35 U.S.C. § 103(a) as unpatentable over Yuen in view of Noguchi; and rejected claims 15-23 and 28 under 35 U.S.C. § 103(a) as unpatentable over Yuen in view of Noguchi.<sup>1</sup> Applicants respectfully traverse the Examiner's rejection under both § 102 and § 103.

### **Regarding Claim Rejections under 35 U.S.C. § 102**

Applicants respectfully traverse the Examiner's rejection of claims 5 and 6 under 35 U.S.C. § 102(b) as anticipated by Yuen. To anticipate Applicants' claimed invention under 35 U.S.C. § 102, each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989), emphasis added.

Independent claim 5 recites a combination including, for example, "selecting a specific music number or tune corresponding to the displayed representative image."

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Yuen fails to disclose at least "selecting a specific music number or tune corresponding to the displayed representative image," as recited by claim 5.

Yuen teaches "[a]n indexing VCR having the ability to recover and store selected video frames as still pictures to enhance a textual directory either in RAM associated with the VCR or on the magnetic tape." Yuen, column 3, lines 46-49. The indexing VCR uses the directory "to assist in selecting a program by use of still video frame pictures." Yuen, column 4, lines 46-48. The program including "[c]losed captioning and text mode data are generally transmitted on VBI line 21, field 1 of the standard NTSC video signal." Yuen, column 3, lines 55-57. However, Yuen's general mentioning of a textual directory to assist selecting an NTSC program does not constitute a teaching of "selecting a specific music number or tune corresponding to the displayed representative image," as recited in claim 5 (emphasis added).

In applying Yuen, the Examiner cited that "a third unit configured to select a specific music number or tune corresponding to the displayed representative image (Col 4, lines 47-49 'a directory as described below to assist in selecting a program by use of still video frame pictures' and Col 9, lines 29-31 'a commercially produced tape such as ... songs...that contains many titles on it')." (Office Action at 3). Applicants submit that the cited portions of Yuen are not relevant.

In Column 9, lines 28-32, Yuen states that "[t]he second type of tape is a prerecorded tape (PR tape) that is a commercially purchased tape, such as a Raquel Welch work-out tape, a karaoke tape, songs, lectures or speeches, that contains many titles on it or may contain only one program." However, such general description of a tape type does not constitute a teaching of "selecting a specific music number or tune

corresponding to the displayed representative image,” as recited in claim 5 (emphasis added). Furthermore, a title of a prerecorded song does not, with complete details, constitute “a specific music number or tune,” as recited in claim 5 (emphasis added).

Therefore, Yuen fails to disclose each and every element in claim 5 either expressly or inherently. Yuen therefore cannot anticipate claim 5 under 35 U.S.C. § 102. Applicants respectfully request withdrawal of the Section 102 rejection of claim 5.

Independent claim 6, while of different scope, recites similar language to that of claim 5. Claim 6 is therefore also allowable over Yuen for at least the same reasons stated above with respect to claim 5. Applicants also respectfully request withdrawal of the Section 102 rejection of claim 6.

Applicants respectfully traverse the Examiner’s rejection of claim 25 under 35 U.S.C. § 102(b) as anticipated by Noguchi. Noguchi does not anticipate claim 25 because it at least fails to disclose at least “setting the first representative image to represent the combined audio information,” as recited in claim 25.

Noguchi teaches that “one leading picture collectively representing the plurality of parts is extracted and recorded as the play list. . . . Also, when the plurality of parts are collectively reproduced as the play list, one leading picture enables the content of the play list to be easily recognized.” Noguchi, column 20, lines 25-31. In Noguchi, “the user actuates . . . the pause button 20q to select the picture to be registered as the leading picture indicative of the start position of the first part within the new play list.” Noguchi, column, 15, lines 13-19. Therefore, Noguchi’s teaching of a user selected leading picture for a play list does not constitute “setting the first representative image to

represent the combined audio information,” as recited in claim 25, where the first representative image represents the first audio information (emphasis added).

Therefore, Noguchi fails to disclose each and every element in claim 25 either expressly or inherently. Noguchi therefore cannot anticipate claim 25 under 35 U.S.C. § 102. Applicants respectfully request withdrawal of the Section 102 rejection of claim 25.

### **Regarding Claim Rejections under 35 U.S.C. § 103**

Applicants respectfully traverse the Examiner’s rejection of claims 15-23 and 28 under 35 U.S.C. § 103(a) as unpatentable over Yuen in view of Noguchi. In order to establish a prima facie case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143, emphasis added.

Independent claim 15, as amended, recites a combination including, for example, “reproducing management information for managing a manner of reproduction of the music information to search for a plurality of representative images representing one or more pieces of audio information, wherein the music information is configured to be associated with one or more said representative images.” Yuen fails to teach or suggest at least the above element as recited by amended claim 15.

Yuen teaches an indexing VCR 10. “When the user presses the Index button, the indexing VCR 10 determines from the TID that the tape is not a HR tape. The

indexing VCR 10 then goes into PLAY mode and reads the directory from VBI line 20 and displays it on-screen.” Yuen, column 10, lines 51-55. “A frame of the video program that is recorded on tape is selected to be displayed with the directory in text form for one or more of the recorded programs.” Yuen, column 1, lines 46-48.

However, Yuen’s teaching of an index textual directory displayed with a frame of video program does not constitute “reproducing management information for managing a manner of reproduction of the music information to search for a plurality of representative images representing one or more pieces of audio information, wherein the music information is configured to be associated with one or more said representative images,” as recited by amended claim 15 (emphasis added).

Noguchi fails to cure Yuen’s deficiencies. Noguchi teaches displaying menu picture M: “as for the menu picture M, pictures M1 to M6 indicative of the respective programs are displayed within the menu picture M.” Noguchi, column 11, lines 53-54. However, Noguchi’s teaching of displaying multiple pictures as menu picture M does not constitute “reproducing management information for managing a manner of reproduction of the music information to search for a plurality of representative images representing one or more pieces of audio information, wherein the music information is configured to be associated with one or more said representative images,” as recited by amended claim 15 (emphasis added).

Therefore, neither Yuen nor Noguchi, taken alone or any reasonable combination, teaches or suggests all elements of Applicants’ invention as recited in amended independent claim 15. A prima facie case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawn of the Section

103(a) rejection of claim 15. Because claims 16-23 depend from claim 15, Applicants also request withdrawn of the Section 103(a) rejection of claims 16-23 for at least the same reasons stated above.

Applicants respectfully traverse the Examiner's rejection of claim 24 under 35 U.S.C. § 103(a) as unpatentable over Noguchi. Noguchi fails to teach or suggest at least "dividing the audio information into a first audio information and a second audio information," as recited by claim 24.

Noguchi teaches that "one leading picture collectively representing the plurality of parts is extracted and recorded as the play list. . . . Also, when the plurality of parts are collectively reproduced as the play list, one leading picture enables the content of the play list to be easily recognized." Noguchi, column 20, lines 25-31. In Noguchi, "the designation information indicative of the leading pictures of the respective play lists and the start times and the end times of the respective parts stored in the register are stored in the collection of record areas adjacent to the management area on the optical disc 1, as the reproduction control information indicative of the generated play lists." Noguchi, column 16, lines 16-22, emphasis added. Therefore, Noguchi's teaching of combining individual parts into a play list does not constitute "dividing the audio information into a first audio information and a second audio information," as recited by claim 24.

At page 6 of the Office Action, the Examiner states that he "takes official notice that designating a starting point for playback of a clip and an end point for playback of a clip allows the user to designate a second starting point for playback of the clip at or immediately after the first end point for playback of the clip, as is understood by those of ordinary skill in the art." (Office Action at 6). Applicants respectfully disagree with the

Examiner. As explained above, Noguchi teaches combining individual parts into a play list with each part having a start time and an end time. Thus, the Examiner's official notice on "a second starting point for playback," even if taken properly by the Examiner (which it is not<sup>2</sup>), is contrary to the teaching of Noguchi.

Therefore, Noguchi fails to teach or suggest all elements of Applicants' invention as recited in claim 24. A prima facie case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawn of the Section 103(a) rejection of claim 24.

Applicants respectfully traverse the Examiner's rejection of claims 26 and 27 under 35 U.S.C. § 103(a) as unpatentable over Yuen in view of Noguchi. Claims 26 and 27 depend from claims 5 and 6, respectively. As explained above, Yuen fails to disclose, at least, "selecting a specific music number or tune corresponding to the displayed representative image," as recited by claim 5, and "a third unit configured to select a specific music number or tune corresponding to the displayed representative image," as recited by claim 6. Noguchi fails to cure Yuen's deficiencies.

Noguchi teaches displaying menu picture M: "as for the menu picture M, pictures M1 to M6 indicative of the respective programs are displayed within the menu picture M." Noguchi, column 11, lines 53-54. However, Noguchi's teaching of displaying multiple pictures as menu picture M does not constitute a teaching of "selecting a specific music number or tune corresponding to the displayed representative image," as

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<sup>2</sup> "Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." M.P.E.P. § 2144.03.A.

recited by claim 5, or "a third unit configured to select a specific music number or tune corresponding to the displayed representative image," as recited by claim 6.

Therefore, neither Yuen nor Noguchi, taken alone or any reasonable combination, teaches or suggests all elements of Applicants' invention as recited in amended claims 5 and 6. A prima facie case of obviousness has not been established. Because claims 26 and 27 depend from claims 5 and 6, respectively, and incorporate the limitations of their respective independent claims, claims 26 and 27 are allowable because Yuen and Noguchi fail to teach or suggest all elements of each claim. Accordingly, Applicants respectfully request withdrawn of the Section 103(a) rejection of claims 26 and 27.

**Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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